IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/781,925	02/12/2001	Karen Capers	2001P07466US01

Response To **OFFICIAL ACTION PURSUANT TO 37 CFR 1.111**

	EXAMINER
	Ilwoo Park

ART UNIT	PAGE NUMBER
2182	3

BEST AVAILABLE COPY

AMENDMENTS TO THE DRAWINGS

In the Drawings:

[none]

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/781,928	02/12/2001	Karen Capers	2001P07486US01

Response To **OFFICIAL ACTION PURSUANT TO 37 CFR 1.111**

EXAMINER
Ilwoo Park

ART UNIT	PAGE NUMBER
2182	10

REMARKS

This Application has been carefully reviewed in light of the final Office Action mailed October 18, 2006 ("Office Action"). Claims 1-19 and 21 currently stand rejected.

Section 102(e) Rejections

Claims 1-19 and 21 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Publication No. 2002/0069272 A1, issued to Kim, et al. (*"Kim"*). Applicants respectfully traverse these rejections.

Applicants respectively provide a reminder that in establishing a *prima facie* case of anticipation, "[t]he identical invention *must* be shown in as *complete detail* as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (Emphasis added). Furthermore, "[t]he elements *must* be arranged as required by the claim." *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); M.P.E.P. § 2131. (Emphasis added). With these thresholds requirement in mind, Applicants submit that the PTO has failed to establish a *prima facie* case of anticipation, using *Kim*.

Claim 6 is allowable because *Kim* fails to disclose, expressly or inherently "automatically downloading the network elements from the remote location." As an alleged disclosure of this feature, the PTO points to Paragraphs 0034, 0054, and 0055, but this is incorrect. Paragraphs 0034, 0054, and 0055 mention nothing of downloading network elements, let alone automatically downloading the network elements from a remote location. For at least this reason, Applicants submit that Claim 6 should be allowed as should Claims 13, 15, and 21, and their dependents.

Independent Claim 1 is allowable because *Kim* fails to disclose, expressly or inherently, "automatically applying a specified set of rules to produce a result set based on the service option selection and the capacity information." As an alleged disclosure of this feature, the PTO points to Paragraphs 0036 and 0038 for the "specified set of rules" and FIGURE 3 as the result set, but this is incorrect. The display of FIGURE 3 is generated before a user actually modifies a parameter. *See Kim*, Paragraph 0038. Accordingly, the alleged result set of FIGURE 3 cannot be based on the service option selection and the capacity information. It can not be disputed that a thing can not be based upon items not yet in existence. Further, if the PTO alleges that

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/761,925	02/12/2001	Karen Capers	2001P07466US01

Response To **OFFICIAL ACTION PURSUANT TO 37 CFR 1.111**

EXAMINER	
Ilwoo Park	
ART UNIT	PAGE NUMBER
2182	11

the result set occurs further downstream after a selection of items in FIGURE 3, then Applicants question where *Kim* shows applying a specified set of rules to produce this result set. Applicants are unaware of any such teachings in *Kim*. For at least this reason, Applicants submit that Independent Claim 1 and its dependents should be allowed. Independent Claims 8, 15, and 21 should be allowed for analogous reasons.

Independent Claim 1 is additionally allowable because *Kim* fails to disclose, expressly or inherently, "automatically determining that one or more network elements are to be included in the integrated communication server based on the result set." As an alleged disclosure of this feature, the PTO points to Paragraphs 0038-0040 and 0054, but this is incorrect for at least three reasons. First, as has been previously indicated, the PTO has already acknowledged in two previous Office Actions that *Kim* does not explicitly disclose this limitation. Specifically, in a Non-Final Office Action of July 14, 2005 and a Final Office Action of December 29, 2005, the PTO indicated that "[*Kim*] fails to explicitly disclose step of 'automatically determining that one or more network elements are to be include in the communication server based on the result set', as claimed."

Second, the PTO in the Office Action never identifies how *Kim's* alleged automatic determination is based on a result set that was produced by automatically applying a specified set of rules. Specifically, when the PTO cites *Kim's* alleged disclose of the above feature, the Office Action is silent on the disclosure of the "result set," focusing only on the word "based." However, the automatic determination is based on the result set, which is (1) produced by automatically applying a specified set of rules, and (2) based on the service option selection and the capacity information.

Third, these portions, in fact, do not disclose this feature. Rather, Paragraphs 0038-0040 disclose the latter part of a method of modifying a server configuration. Specifically, Paragraphs 0038-0040 disclose (1) determining whether a user is allowed to modify a parameter, (2) modifying the parameter, (3) communicating the parameter to a server manager, (4) determining tables to update in a database with the modified parameter, (5) updating the tables with the modified parameter, (6) determining which server to synchronize with the updated tables, and (7) attempting to update the configuration of the servers with the modified parameter. The paragraphs preceding Paragraphs 0038-0040 describe an example parameter

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST-NAMED INVENTOR	ATTORNEY DOCKET NO.
09/781,925	02/12/2001	Karen Capers	2001P07466US01

Response To **OFFICIAL ACTION PURSUANT TO 37 CFR 1.111**

EXAMINER
Ilwoo Park

ART UNIT	PAGE NUMBER
2182	12

of increasing a website from 5 megabytes to 10 megabytes. Paragraph 0054 describe a situation in which a website is increased from 10 megabytes to 500 megabytes, requiring another physical server. Clearly, *Kim's* process of synchronizing servers with a database does not disclose automatically determining that one or more network elements are to be included in an integrated communication server based on a result set. For at least this additional reason, Applicants submit that Independent Claim 1 and its dependents should be allowed. Independent Claims 8, 15, and 21 should be allowed for analogous reasons.

Independent Claim 1 is additionally allowable because *Kim* fails to disclose, expressly or inherently, "automatically determining configuration parameters for the one or more network elements based on the result set." The Office Action alleges that *Kim* discloses this limitation at Paragraphs 0040-0041, but this is incorrect. Paragraph 0040 describes attempting to update the configuration of the servers with a modified parameter. Paragraph 0041 describes determining if the server can update itself with the modified parameter. Paragraphs 0040-0041 mention nothing of automatically determining configuration parameters for the one or more network elements based on the result set.

In response to previous arguments, the Office Action points to the words "server configuration settings" and "instructions" in Paragraphs 0040 and 0041 as an alleged disclosure of configuration parameters. However, neither of these words or the context of them in the paragraph suggest an automatic determination of configuration parameters based on the result set. For at least this additional reason, Applicants submit that Independent Claim 1 and its dependents should be allowed. Independent Claims 8, 15, and 21 should be allowed for analogous reasons.

No Waiver

All of Applicants' arguments are without prejudice or disclaimer. Applicants reserve the right to discuss the distinctions between the applied art and the claims in a later Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicants do not acquiesce to the Examiner's additional statements. The example distinctions discussed by Applicant are sufficient to overcome the anticipation and obviousness rejections.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/781,925	02/12/2001	Karen Capers	2001P07456US01

Response To OFFICIAL ACTION PURSUANT TO 37 CFR 1.111

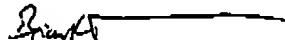| EXAMINER	
Ilwoo Park	
ART UNIT	PAGE NUMBER
2182	13

Request for Evidentiary Support

In establishing rejections, if the Examiner is relying upon "common knowledge" or "well known" principles to establish the rejection, Applicants request that a reference be provided in support of this position pursuant to M.P.E.P. §2144.03. Furthermore, to the extent that the Examiner maintains any rejection based on an "Official Notice" or other information within the Examiner's personal knowledge, Applicants respectfully request that the Examiner cite a reference as documentary evidence in support of this position or provide an affidavit in accordance with M.P.E.P. § 2144.03 and 37 C.F.R. 1.104(d)(2).

In view of the foregoing amendments and remarks, Applicant submits that all of the claims are in proper format and are patentably distinct from the prior art of record and are in condition for allowance.

The Examiner is invited to contact the undersigned at the telephone number listed below with any questions concerning this application.

Respectfully submitted,

PLEASE DIRECT ALL WRITTEN
CORRESPONDENCE TO:
Siemens Networks LLC
170 Wood Avenue South
Iselin, NJ 08830

Brian K. Johnson, Reg. No. 46,808
Attorney for Applicant(s)
phone +1-732-321-3017
fax +1-732-590-6411
email brian.johnson@siemens.com